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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,673	07/24/2003	Naohiro Yoshikawa	03560.002263.1	8897
5514	7590	09/23/2004		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
			EXAMINER GARCIA, GABRIEL I	
			ART UNIT 2624	PAPER NUMBER

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/625,673	<b>Applicant(s)</b> YOSHIKAWA, NAOHIRO	
	<b>Examiner</b> Gabriel I Garcia	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/172,262.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/24/2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

**Part III DETAILED ACTION**

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

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***Double Patenting***

2. The claims 17-31 are rejected under the judicially created doctrine of the obviousness type double patenting of the claims in applicant's prior United States Patent No. 6,624,902. Although the designs are not identical, they are not patentably distinct from each other because both the pending application and the Applications claims are directed to the same invention, a printing control apparatus. (e.g. claim 17 from the application teaches determining means, operation unit (or control unit) and display means, these means and detail features are described in the claims 1-4 of US patent No. 6,624,902. The obviousness type double patenting rejection is a judicially established doctrine based on public policy, and is primarily intended to prevent prolongation of monopoly by prohibiting a claim in a second patent not patentably distinguishable from a claim in a first patent.

A timely filed terminal disclaimer will obviate this rejection. (MPEP... § 1490) *In re Vogel*, 164 USPQ 619 (CCPA 1970).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 17-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Thiel (6,389,327).

With regard to claim 17, Thiel teaches a printing control apparatus (e.g. abstract, controlling the printing of mail) comprising: a determining unit for determining whether a designated type of paper is an envelope (e.g. col. 3, lines 18-39); and an operation unit for performing a printing operation to form an image on the designated type of paper without rotating

the image when said determining unit determines that the designated of paper is not envelope (e.g. col. 3, lines 18-67, and col. 5, lines 58-64, the printing additional printing or letter) and performing the printing operation to form the image on the designated type of paper with the image being rotated when said determining unit determines that the designated type of paper is an envelope (e.g. col. 3, lines 18-67, printing on an envelope).

With regard to claim 18, Thiel teaches a printing control apparatus (e.g. abstract, controlling the printing of mail) comprising: a determining unit for determining whether a designated type of paper is an envelope (e.g. col. 3, lines 18-39); and display unit (e.g. col. 13, lin 16) for displaying information for setting the designated type of paper in a reverse orientation when said determining unit determines that the designated of paper is an envelope (e.g. col. 3, line 18 thru col. 4, line 7).

With regard to claim 19, Thiel teaches wherein said display unit displays information for setting an unsealed end of the envelope in a front position and a sealed end of the envelope on the side of a printer (e.g. col. 2, lines 7-46 and col. 13, lines 11-48).

With regard to claims 20 and 23, the limitations of claims 20 and 23 are covered by the limitations of claim 17 above.

With regard to claims 21,22,24,25, and 26-31, the limitations of claims 21,22,24,25, and 26-31 are covered by the limitations of claims 18-19 above.

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### Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Button et al. (6,131,722) teaches a high speed envelope packing apparatus.

Cheong (6,053,491) teaches a sheet feeder.

Kobayashi et al. (5,921,691 and 5,785,441) teaches a paper discharge section for a printer.

Ruggiero et al. (5,809,749) teaches a high speed envelope packing apparatus.

Saito et al. (5,731,829) teaches a recording apparatus with two recording medium conveyance routes.

Kapp et al. (4,733,310) teaches a paper sheet and envelope feeder apparatus.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I.**

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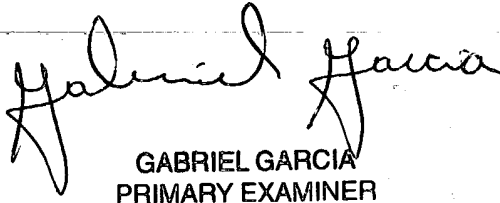
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Garcia whose telephone number is (703) 305-8751. The examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone numbers for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Gabriel I. Garcia  
Primary Examiner  
September 20, 2004



GABRIEL GARCIA  
PRIMARY EXAMINER